

REMARKS:

This amendment is for the purpose of amending the Specification in the original application by amending claims 1 - 4, 11 - 14, 20 and provide traverse of portions of the rejections to overcome the rejections advanced by the Examiner in the instant office action. Applicants believe that these amendments to the claims and traverse in part of the rejections put the application in condition for allowance and respectfully request reconsideration and allowance of claims 1 - 15, 17 - 18 and 20.

The Official Action rejects claims 1 - 4, 6 - 7, 11 - 15, 18 and 20 under 35 U.S.C. 102(b) as being anticipated by Tsukioka, U. S. Patent 5,733,638. Specifically, the Examiner states that Tsukioka discloses a hot stamped material comprising a base and inner release layer which are laminated to the base for coating food wrapping materials where the laminate includes a film laminated to a paper support and hot stamp printing on the laminate. The Examiner continues the rejection by saying that Tsukioka further discloses that the sheet is rolled into a foil, which includes a color layer. Applicants provide traverse of the rejection as Applicants do not claim rolling the sheet into a foil since the "foil" is a transfer foil already provided on a carrier sheet. The word "foil" may be used in many contexts. For instance, the word "foil" can denote a thin, usually metallic wafer that has been mechanically reduced in thickness from a thicker billet of material or in the context of the instant invention, where the word "foil" has the industry wide definition previously set forth in the Amendment A to the Office Action dated 08 May 2002. Therein, Applicants established that a "film" denotes a sheet to be wrapped about a substrate, a "foil" indicates a transfer product and a "carrier" indicates the backing sheet for a "foil." Tsukioka clearly defines "foil" as a thin wafer reduced in thickness by beating or rolling a larger slug of material into a foil in the cited lines 26 - 30 of column 6, specifically in lines 26 and 27. Applicant does not claim, nor even discuss, that the sheet is beaten or rolled into a foil but rather that as already existing "foil" carried on a carrier is laminated onto a planar wrapping paper. It should be abundantly clear that no reduction in thickness of any of the materials is discussed, shown or claimed in Applicants' disclosure. Applicants do not discuss a "sheet" except in discussions of the prior art.

Also, in Col. 6, lines 23 - 27 Tsukioka discusses the intermediate layer, while in lines 28 - 37 Tsukioka discusses the "basic structure" which includes a base carrier, the

intermediate layer, the release layer, an adhesive layer of edible material and may further include a "color layer." Applicants are not concerned with the color or the nature of the foil or the color or nature of the paper but rather that at least one hot transfer inked foil is laminated onto a planar wrapping paper thereby marrying the hot transfer foil to the planar wrapping paper. Tsukioka merely describes a hot transfer foil as fully described and known in the industry as all hot transfer foils comprise a carrier, a release layer disposed on the carrier, the foil and a top adhesive. Applicants provide a novel material by laminating one hot transfer inked foil to a planar paper as in claim 1 or onto an embossed paper as in claim 11 or onto a scored surface of an inked paper as in claim 20 and provide yet another novel material by laminating at least one other hot transfer inked foil onto a first hot transfer inked foil already disposed on the planar paper as recited in claim 2 or the embossed paper as in claim 12. The structural difference lies in location of the adhesives and the location of the color and the location of the release. The Examiner's attention is drawn to sandwiches below representing Tsukioka and Applicants, respectively.

TSUKIOKA Claim 1 = Fig. 14
Composite

APPLICANTS' Claims 1, 11, 20
Decorative Wrapping Film

Base 6
Release layer 7

Carrier
Release layer

Above removed from intermediate layer

Above removed from each hot transfer foil

Intermediate Gold or Silver Layer 8
Adhesive layer 9
(alternate color layer)
Release layer R1, R2
Edible material SO
Adhesive zein layer Z1
Support T1, T2 or Y1

(At least 1) {Hot transfer foil
{ Adhesive
{Hot transfer foil
{ Adhesive
Decorative surface
Wrapping paper

A careful study of the sandwiches presented above reveals the structural differences as Tsukioka has 1) a release layer remaining in the sandwich and 2) does not have a decoration directly on the support as do Applicants. Furthermore, in Applicants structure, the first layer above the support may be a color or decorative pattern whereas in

Tsukioka, the color layer is at least above the first adhesive and the edible layer. Additionally, it is readily apparent that the only similarities occur at the top two layers, i.e. the hot stamp foil and the adhesive below the hot stamp foil as these are common industry materials normally laminated to the carrier below the release layer, e.g. a hot transfer foil.

With respect to the Examiner's statement that Tsukioka discloses a hot stamp material transferring to a substrate by means of an adhesive as the Examiner asserts in the first two lines on page 3 of the instant office action, Applicants are fully aware of the transfer of hot stamp material as the product and its method of application have been known in the industry long before the filing of Tsukioka. Furthermore, though Tsukioka claims, discusses and shows that the hot stamp material may be applied to both sides of an edible material SO, Applicants apply at least one hot stamp foil only to the exposed surface of the wrapping paper or the exposed surface of another hot stamp foil already applied to the wrapping paper as it would be counterproductive to apply a hot stamp foil to the blind surface.

The Examiner additionally says that Tsukioka discloses the substrate is embossed in column 16, lines 20 - 25, however, a careful reading reveals that the "... image M1 can be transferred to the underlying substrate by various methods, ... including ... embossed by means of a hot stamp plate containing a pattern ..." which means that the substrate is not embossed but rather the image is an embossing upon the substrate. Applicants, on the other hand, provide a wrapping paper which is already an embossed paper to which the hot stamp foil is transferred to decorate the embossed surface with the particular features of the foil.

In addition to the above traverse showing that the independent claims clearly have a structural difference over Tsukioka and all other references cited in this application, Applicants have amended claims 3 - 4 and 13 - 14 by deleting the phrase "to be decorated" thus overcoming the 'capable of' rejection. Furthermore, Applicants have amended claims 1 - 2, 11 - 12 and 20 by deleting the phrase "for use in wrapping of a substrate" thus overcoming the 'intended use' rejection. It is abundantly clear by reference to the sandwiches constructed above that a structural difference is already present.

The Examiner states that the phrase "hot transfer inked foil having a portion of the ink thereon removed prior to being laminated onto a planar paper wrapping film" introduces a process limitation to the product claim. Accordingly, Applicants have amended claim 20 by removing the offending process step while retaining the featured base decoration showing through the hot transfer inked foil thus overcoming the Examiner's rejection of claim 20. As Applicants have amended claims 1 - 4, 11 - 14 and 20 as discussed above and provided traverse of the remainder of the rejection as purportedly anticipated by Tsukioka, Applicants thus believe that claims 1, 11 and 20 and the dependent claims depending therefrom are in condition for allowance. Accordingly, Applicants respectfully request reconsideration and allowance of claims 1 - 15, 17, 18 and 20.

The Official Action rejects claims 1 - 10 under 35 U.S.C. 102(b) as being anticipated by Phillips, et al., U. S. Patent 5,186,787. Applicants have amended claim 4 by removing the phrase "to be decorated," amended claims 1 and 2 by deleting the phrase "for use in wrapping of a substrate" and amended claim 3 by removing the last phrase "said paper decorative wrapping film wrapped about a substrate to be decorated." Applicants believe that the above amendments to claims 1 through 4 place the application in condition for allowance and respectfully request reconsideration and allowance of claims 1 - 10.

The Examiner states that Phillips, et al., disclose a hot stamp transfer imaged foil, carried on a releasable carrier, which is hot stamped onto a substrate, such as paper or film where the composite is wound upon a roll and comprises a multilayer coating. Applicants provide traverse of this grounds for rejection as follows: As stated above with regard to the same rejection as anticipated by Tsukioka, the Examiner's recitation is that of a standard procedure well known in the art. Additionally, a careful reading of Phillips, et al., will reveal that the **process** may be a roll-on process whereby the hot stamp is applied to the substrate by passing the substrate and the hot stamp foil between heated rolls. Obviously, Phillips, et al., use the word "roll" in an action state by referring to a "roll-on" process whereas Applicants use "roll" in the nominative case to indicate an object, i.e. a roll of material. There is nothing in Phillips, et al., that says the finished material is wound

on a roll as recited in Applicants' claims and disclosure. A careful reading of Applicants' disclosure reveals that Applicants have a hot stamp transfer foil disposed on an already decorated wrapping film by passing the hot stamp foil and the already decorated wrapping film between heated rolls **and that the subsequent product is wound upon a roll.** Emphasis added. Thus, Applicants provide a structure that has a paper wrapping film with a first decoration and thereafter provide at least one other decoration upon the first decoration prior to winding the finished product into a roll. For a ready reference, Applicants provide below the sandwiches of Phillips, et al., and Applicants.

Phillips, et al. Fig. 6 Composite	APPLICANTS' Claim 1 Decorative Wrapping Film
Carrier (26)	Carrier Release layer
<i>Above removed from release hardcoat</i>	<i>Above removed from each hot transfer foil</i>
Optional printing (47)	(At least 1) {Hot transfer foil
Optional overcoat (46)	{ Adhesive
Release hardcoat (28)	{Hot transfer foil
Image (29)	{ Adhesive
Adhesive (41)	Decorative surface
Substrate (38)	Wrapping paper

As with Tsukioka, the structural difference lies in location of the adhesives and presence or absence of the release. A careful study of the sandwiches presented above reveals the structural differences as Phillips, et al., have 1) a release layer remaining in the sandwich and 2) do not have a decoration directly on the support as do Applicants. Furthermore, in Applicants structure, the first layer above the support may be a color or decorative pattern whereas in Phillips, et al., the image is at least above the first adhesive. Coupled with Applicants' deletion of the offending "capable of," the "intended use" and "process" limitations and the discussion above clearly showing Applicants' differences from any prior art reference, Applicants believe that claims 1 - 10 are now in condition for

allowance. Applicants respectfully request reconsideration and allowance of claims 1 - 10 as amended.

Claim 20 is not included in the rejection as anticipated by Phillips, et al., though the comments provided above with respect to claim 20 as anticipated by Tsukioka fully apply.

The Official Action rejects claims 11 - 15, 17 - 18 under 35 U.S.C. 103(a) as being unpatentable over Phillips, et al., U. S. Patent 5,186,787 in view of Boswell, U. S. patent 5,786,017. Applicants have amended claim 14 by removing the offending phrase 'to be decorated,' amended claim 13 by removing the last process phrase "said laminated embossed wrapping paper wrapped about a substrate to be decorated," and further amended claims 11 and 12 by deleting the phrase "for use in wrapping a substrate" in a bonafide attempt to put these claims in condition for allowance. In the rejection, the Examiner states that Boswell teaches a hot stamp transfer imaged foil, which is hot stamped onto a substrate, such as paper or film, which has adhesive on the back side of the film and an embossed image. The Examiner further states that Phillips, et al., and Boswell are directed to hot stamp transfer foils and that it would have been obvious to employ the embossed surface as taught in Boswell, in the decorative film of Phillips to improve the texture and appearance of the decorative film. Applicants provide traverse of the argument advanced by the Examiner as follows. A careful reading of Boswell reveals that the decorated surface is embossed **after** the structure is finished whereas Applicants apply a hot transfer foil to an already embossed surface. Thus, in Boswell, the entirety of the embossed portion has the characteristics of the layer B, which is a release coat, not a decoration, while in Applicants' disclosure the embossed surface receives the hot transfer foil only on the uppermost raised surfaces. Not only is the nature of the structure different, that is, the upper most layer is already embossed in Applicants' disclosure while it is embossed after completion in Boswell, the nature of the layers are also different as the uppermost layer is a release layer in Boswell and a decorative surface in Applicants' disclosure. Embossing a surface of a substrate after wrapping same with a decorative film is the subject of another application filed by some of the Applicants hereof.

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Applicants provide further traverse of the rejection set forth by the Examiner in that although Boswell and Phillips employ hot stamp transfer foils, so do Applicants. It is not the hot stamp transfer foil itself that is sought to be patented in Applicants disclosure as hot stamp transfer foils are well known and widely used in the industry, rather Applicants seek to patent a novel structure that is paper decorative wrapping film comprising at least one hot transfer inked foil carried on a carrier, at least one hot transfer inked foil laminated onto an embossed wrapping paper thereby marrying the hot transfer foil to the embossed wrapping paper, the marrying creating a laminated embossed wrapping paper wherein the carrier is removed from the laminated embossed wrapping paper, the laminated embossed wrapping paper having an adhesive disposed on a side of the laminated embossed wrapping paper opposite the hot transfer foil and the embossed laminated wrapping paper is wound upon a roll wherein the planar wrapping paper usually already has a decorative surface, whether colored, grained or embossed. Sandwiches for Phillips, et al., in view of Boswell are provided for the Examiner's reference.

PHILLIPS, ET AL. V/O BOSWELL
Composite

APPLICANTS' Claim 11
Decorative Wrapping Film

Phillips, et al., carrier (26)

Carrier
Release layer

Above removed from release hardcoat

Above removed from each hot transfer foil

Boswell, Embossed release coat (B)
Phillips, et al., Overcoat (46)
Phillips, et al., Release hardcoat (28)
Phillips, et al., Image (29)
Phillips, et al., Adhesive (41)
Phillips, et al., Substrate (38)

(At least 1) {Hot transfer foil
{ Adhesive
{Hot transfer foil
{ Adhesive
Decorative surface
Wrapping paper

It becomes abundantly clear that Phillips, et al., in view of Boswell results only in an embossed release coat substituted for the printing layer of Phillips, et al., which Phillips, et al., effectively create with the optional printing. Therefore, Boswell provides

nothing new to the body of art and as Phillips, et al., falls with respect to the independent claims, Phillips, et al., in view of Boswell falls also. Applicants believe that by amending claims 11 - 14 as recited above and by providing traverse of the rejection of Phillips, et al., in view of Boswell, Applicants have put these claims along with those dependent thereupon in condition for allowance. Applicants respectfully request reconsideration and allowance of claims 11 - 15 and 17 - 18.

Applicants believe that by amending claims 1 - 4, 11 - 14 and 20 to remove the "capable of," "intended use" and "process" limitations and providing traverse in part of the rejections included in the office action, Applicants have overcome the rejection of claims 1 - 15, 17 - 18 and 20 based upon under 35 U.S.C. 102(b), and 35 U.S.C.103(a) thereby placing this application in condition for allowance. Thus, claims 1 - 15, 17 - 18 and 20 remain in this application and Applicants respectfully request reconsideration and allowance thereof.

In view of the above, an Action on the merits of this application, as amended, and an allowance thereof is respectfully requested.

Respectfully submitted,

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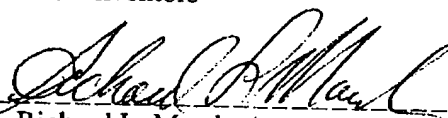
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